

30. (Amended) The purified polynucleotide of claim 28 wherein said polynucleotide is produced by synthetic techniques.

REMARKS

1. Amendment of Claims 29 and 30.

Claims 29 and 30 incorrectly depended upon claim 1. This error has been corrected.

2. Examiner's Rejection of Claims 28-33 under 35 U.S.C. § 112 first paragraph.

The Examiner alleges that the specification does not provide enablement for SEQUENCE ID NOS: 23 and 24.

Applicants strongly disagree. Applicants amended the specification in January 27, 2000, in response to Office Action of August 27, 1999. The amendment included language referring to SEQUENCE ID NOS: 23, 24 and 25 (to be added on page 52, line 6, after "was derived", see Amendment page 2, first paragraph). The consensus sequences SEQ ID NO: 23 and SEQ ID NO: 24 (clones 1430502 and 2513529) in the present application, are identical to SEQ ID NO: 2 and to SEQ ID NO: 4 in the parent case U.S. Serial No. 08/828,845 (clones 1430502 and 2513529, respectively). Exhibit A contains a direct comparison of these sequences to each other and evidences this equivalence. Based upon this evidence, Applicants submit that the specification is enabling for SEQUENCE ID NOS: 23 and 24. Therefore, Applicants respectfully request that this rejection be withdrawn.

3. Examiner's Rejection of Claims 28-32 under 35 U.S.C. § 102 (e).

The Examiner alleges that Claims 28-32 are anticipated by Lal et al. (US Patent 5,856,139, hereinafter the "'139 patent"), because it teaches a polynucleotide comprising both SEQ ID NO: 2 and SEQ ID NO: 25.

Applicants disagree. For prior art to anticipate under 35 U.S.C. § 102 the prior art has to disclose each and every element of the claimed invention, such a determination is one of fact (*Hybritech Inc. v. Monoclonal Antibodies*, 802 F.2d at 1367, 231 USPQ 81 (Fed. Cir. 1986)).

SEQ ID NO: 2 of the '139 patent is a polynucleotide of 420 base pairs. SEQ ID NO: 2 of the '139 patent contains SEQ ID NOS: 2 and 24 of the present application plus a fragment of 124 base pairs of SEQ ID NO: 25 of the present application (SEQ ID NO: 25 of the present application comprises a total of 300 base pairs).

The claims in the present application comprise SEQUENCES ID NO: 1, 2, 23, 24 and 25. The '139 patent does not teach the specific isolated and purified sequences of the present invention. Thus it cannot be said that the '139 patent anticipates the present invention.

Therefore, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the aforementioned remarks, the application is in condition for allowance and Applicants request that the Examiner withdraw all outstanding rejections and passes this application to allowance.



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MARKED UP VERSION OF CLAIMS

29. (Amended) The purified nucleotide of claim [1] 28 wherein said polynucleotide is produced by recombinant techniques.
30. (Amended) The purified polynucleotide of claim [1] 28 wherein said polynucleotide is produced by synthetic techniques.